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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,710

09/08/2006

Gerd Ritzdorf

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EXAMINER

LEWIS, KIM M

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

06/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/598,710	RITZDORF ET AL.	
	Examiner	Art Unit	
	Kim M. Lewis	3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,35-38 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,35-38 and 40-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/8/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 4/1/10 has been received and made of record. As requested, claims 33 and 41 have been amended, claim 39 has been cancelled, and claim 53 has been added.
2. Claims 33, 35-38 and 40-53 are pending in the instant application.

Specification

3. The disclosure is objected to because of the following informalities:

Page 6, lines 9-11, recites the term "carrier" in reference to the layer on which the adhesive is applied. It is unclear if this carrier is the "backing" or the "releasable protective layer"/ silicone-treated paper. Note for example, page 1, lines 3-6, page 2, lines 7-11, and page 7, line 19-page 8, line 3 of the specification. It is however clear that the text is not in reference to "a carrier bandage" distinct from the backing or the releasable protective layer/ silicone-treated paper. Thus, the examiner is not clear as to what the carrier refers.

Page 2, delete the reference to "claim 1".

Appropriate correction is required.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the adhesive applied across the entire surface of or on a part of the underside of a carrier bandage or in the form of patterns must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As regards claim 33, the recitation that "the adhesive is applied across the entire surface of or on a part of the underside of a carrier bandage or in the form of patterns" is not supported by the original specification. Page 6, lines 9-11 of the specification only recites the following: "...the adhesive being applied across the whole surface of or at least on a part of the underside of the carrier and/or in the form of patterns...". Thus, either the carrier represents the backing or the releasable protective paper/silicone treated release paper, but not an additional bandage.

Claim Interpretation(s)

7. The amended language in Claim 33 is being interpreted as the following:
characterized in that the adhesive is applied across the entire surface of or on a part of the underside of the backing or in the form of pattern.

Response to Arguments

8. Applicant's arguments filed 4/1/10 have been fully considered but they are not persuasive.

9. First, applicants' argue that the combination of Schafer, Fabo, Lindqvist et al. and Ganter does not teach adhesive applied across the entire surface of or on a part of the underside of a carrier bandage or in the form of patterns. First, applicants should note that Ganter has been dropped as a reference. Second, Fabo discloses such a feature (note textile material 2). Applicants should additionally note that as interpreted, amended claim 33 neither defines over the adhesive layers Fabo nor the adhesive layer of Lindqvist et al. As can be seen from the figures of Fabo, Fabo discloses a carrier layer that has the adhesive gel layer applied across the surface in a pattern consistent with the surface of the carrier, and Lindqvist et al. discloses the adhesive gel layer applied across the entire underside of the backing layer(2).

10. With respect to applicants' argument that it cannot be presumed that a highly elastic bandage has applicant's claimed degree of elasticity, the examiner contends that a highly elastic bandage is at the very least 50% elastic, and the examiner has further provided in the rejection and well as in the previous response to the arguments, the obviousness of adjusting the elasticity of the bandage depending upon the indication through routine experimentation and has even gone so far as to even cite *In re Aller*.

11. As to applicants' remarks that the examiner treats a bandage for wounds as indistinguishable from joint supports, the examiner contends that a bandage is a bandage and is capable of use on all body parts unless otherwise disclosed. Thus, since nothing in Fabo or Lindqvist et al. precludes their use on a joint, the examiner may conclude that it is capable of use thereon. Furthermore, applicants should note Fabo and Lindqvist et al. were cited for teaching the known use of adhesives on the skin

having an adhesion force that either lies within or touches applicant's' claimed adhesion force range. Additionally, Fabo and Lindqvist et al. were cited for teaching the conventional use of protectors on adhesives in order to protect adhesive prior to use.

12. As to the expectation of success, since both Schafer and the Fabo/Lindqvist dressings are applied to the skin and adhere without incidence, it is expected that the modification of the device of Schafer to include the adhesive of Fabo or Lindqvist et al. would be equally successful and adhere to the skin of the user without incidence.

13. As to the arguments presented for claim 53, note the rejection below.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 33, 35-38 and 40-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,424,808 ("Schafer et al.") in view of U.S. Patent No. 5,540,922 ("Fabo") and/or U.S. Patent No. 6,051,747 ("Lindqvist et al.").

As regards claims 33 and 35-38 and 40, Schafer et al. discloses a wide rectangular elastic bandage fabric that substantially discloses applicants' invention. More specifically, Schafer et al. discloses an elastic fabric bandage which is adhesively or self-adhesively coatable one side (col. 7, line 66-col. 8, line 4). The bandage is highly longitudinally elastic in the warp or weft directions (*i.e.*, in the transverse or longitudinal directions), thereby being unidirectionally elastic. Applicants should note that the bandage fabric itself is a segment and is tearable into further segments, and that the **"highly longitudinally elastic"** property inherently equates to at least 50% elasticity.

Assuming *arguendo* that applicant contends that the highly longitudinally elastic fabric does not inherently possess an elasticity of between 20% to 150%, the examiner contends that it would have been obvious to one having ordinary skill in the art to modify the elasticity bandage of Schafer et al. to attain an elasticity between 20% to 150%

depending upon the indication as recited in col. 2, lines 39-47. Applicant should also note that it has been held that "[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, depending upon the indication, it would have been further obvious to one having ordinary skill in the art to discover the optimum or workable ranges of elasticity by routine experimentation.

Schafer et al. fails to teach that the adhesive or coadhesive layer has an adhesion force of 1-10.0 N and a releasable protective layer. However, both Fabo and Lindqvist et al. disclose an absorbent wound dressing having a silicone gel adhesive layer that has an adhesion force that either touches or lies within applicant's claimed range (note the range of 0.1 to 2 N at col. 1, lines 61-63 of Lindqvist et al. and the range of 0.2 to 10 N/50 mm at col.3, lines 43-47 of Fabo). Fabo also discloses at col. 2, lines 48-51, that protective strips may be added and then removed from the adhesive surface.

Thus, it would have been obvious to one having ordinary skill in the art to substitute the adhesive of Schafer et al. for the adhesive in Fabo or Lindqvist et al. in order to provide a device with a low adhesion force that is gentle on the skin when removed, and further obvious to add protective strips to the device of Schafer et al. in order to protect the adhesive prior to use as is done in Fabo.

Applicant is reminded that it has been held that where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for

another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S. Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

As regards claim 52, the modified device of Schafer et al. as discussed above in the rejection of claim 33 above substantially discloses all features of the claimed method. The modified device does not explicitly recite that the protective film strips are silicone treated. However, silicone treatment of release sheets is commonly known in the art. Thus, it would have been *prima facie* obvious to one having ordinary skill in the art to employ silicone treated protective strips as an obvious design choice.

Furthermore, Schafer et al. fails to teach punching bandage segments. However, it is also commonly known that during the manufacturing of bandages, that bandage rolls or strips are cut or punched from larger rolls. Thus, it would have been *prima facie* obvious to one having ordinary skill in the art to punch/cut the modified bandage of Schafer et al. in order to provide bandage in the desired size.

As regards claims 42 and 43, Schafer discloses the fabric (backing layer) is constructed from non-biodegradable material such as rubber.

Re. claims 44 and 45, the fabric is woven and is therefore breathable due to the spaces between the weft and warp threads.

As regards claims 46 and 47, Schafer et al. discloses that the fabric may be constructed from covered rubber threads and that covering may take place with cotton, staple fibre, polyfilic textured polyamide or other textured synthetic fibers (col. 1, line 67- col. 2, line 19). Absent a critical teaching and/or a showing of unexpected results derived from the use of polyethylene, polypropylene or polyester material as a polymer chosen in the construction of the backing material, the examiner contends that it would have been within the level of ordinary skill in the art to choose a well known synthetic polymer such as polyethylene, polypropylene, polyester or polyalkylene terphthalates as the material for the covering since the type of material used does not patentably distinguish applicant's invention.

As regards claims 48-51 and 53, the modified device of Schafer et al. fails to teach the unidirectionally elastic adhesive bandage as claimed in claim 45, characterized in that the porosity of the film is in the range of 10 to 50%, the

unidirectionally elastic adhesive bandage as claimed in claim 45, characterized in that the backing layer has a warp number in the range of 300-350, and a weft number in the range of 100-140, the unidirectionally elastic adhesive bandage as claimed in claim 49, characterized in that the backing layer has a warp number in the range of 310-330 and a weft number in the range of 120-130, and the unidirectionally elastic adhesive bandage as claimed in claim 33, characterized in that the bandage segment is rectangular with a side ratio of length to width of 1.2:1 to 1.8:1. The examiner contends that the claimed features are not novel and that it has been held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, it would have been obvious to one having ordinary skill in the art, through routine experimentation, to determine the optimum or workable ranges of the porosity, weft and warp numbers and the side ratio of length to width.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Monday to Wednesday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kim M. Lewis/
Primary Examiner
Art Unit 3772

Kml
June 14, 2010